

REMARKS

Claims 8, 9, 11-15 are pending.

Although applicants disagree with the Restriction Requirement and the election of species requirement, claims 1-7 and 16-64 have been canceled as having been withdrawn from consideration as a result of the Restriction Requirement. Claim 10 has been canceled as an essential duplicate of claim 8. Claims 8-15 were examined to the extent readable on the elected process of using tert-butyl hydroperoxide in the presence of a vanadium catalyst.

The amendment to claim 8 is supported by the original claim 10 and Examples 3-5, which used a molar ratio of tert-butyl hydroperoxide versus the benzimidazole thioether compound of formula B at 1.34:1, 1.37:1 or 1.42:1, and also the molar ratios of tert-butyl hydroperoxide versus the compound of formula B used in the experiments disclosed in Table I in page 12 as follows: 1.15:1, 1.15:1, 1.5:1, 1.5:1, 1.5:1, 1.5:1, 4.5:1 and 1.15:1.

Claim Rejection -- 35 U.S.C. 102

Applicants respectfully traverse the rejection of claims 8-15 as being anticipated by Monserrat (ES 2,063,705). Claim 10 has been canceled. Claim 8 has been amended to recite that the molar ratio of the tert-butyl hydroperoxide and the benzimidazole thioether compound of formula B is within the range of “about 1.34 to about 4.5”. Since Monserrat merely discloses using tert-butyl hydroperoxide in excess over the benzimidazole thioether substrate in page 6, lines 10-11 and Monserrat merely used a molar ratio of 1.09 of tert-butyl hydroperoxide versus the benzimidazole thioether substrate in Example 6, Monserrat does not anticipate claims 8, 9 and 11-15. Because Monserrat fails to disclose every recitation of claims 8, 9 and 11-15, withdrawal of the anticipatory rejection is requested.

Claim Rejection -- 35 U.S.C. 103

Applicants respectfully traverse the obviousness rejection of claims 8-15 over Monserrat (ES 2,063,705). Monserrat differs from claims 8, 9 and 11-15 at least in that Monserrat merely discloses generically a molar ratio of greater than one, and specifically a molar ratio of 1.09, for tert-butyl hydroperoxide versus the benzimidazole thioether substrate, instead of the “about 1.34:1 to about 4.5:1” molar ratio recited in these claims. Applicants submit that there would

have been no guidance in Monserrat to lead a person of ordinary skill in the art to the molar ratio of "about 1.34:1 to about 4.5:1". Withdrawal of the obviousness rejection is requested.

Double Patenting Rejection

Applicants respectfully traverse the provisional obviousness type double patenting rejection over claims 1-7 of the co-pending application, No. 10/655,645. However, to advance prosecution, applicants would file a terminal disclaimer if and when at least some of the instant claims are found to be allowable. Applicants request that the rejection be held in abeyance.

CONCLUSION

The Examiner is urged to contact the undersigned by phone if there is any issue that can be resolved with a telephone interview.

In the event that the filing of this Amendment is deemed not timely, applicants petition for an appropriate extension of time. The petition fee, and any other fees that may be required in relation to this paper, can be charged to Deposit Account No. 11-0600.

Respectfully submitted,

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